REMARKS

This paper is responsive to the Office Action mailed on September 30, 2005 in connection with the above-identified patent application. Applicants respectfully request that the application be reconsidered and allowed based on the following remarks.

The current status of the claims

Claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft Word 2000, (c) 1983-1999 by Microsoft Corp. (hereinafter "MS Word") in view of William B. Hayes, *Using PowerBuilder 6* (QUE Corp. 1997) (hereinafter "PowerBuilder"). Office Action at page 3.

Applicants note that although the same two references are applied in the present Office Action as in the previous Office Action mailed April 18, 2005, the rejections are new in substance. The present Office Action cites different dialog windows of the MS Word program. MS Word implements a large number of different dialog windows – thus, as per MPEP § 707(c)(2) it is incumbent upon the Examiner to identify which alleged features of the complex MS Word reference are relied upon in making the rejection. The present Office Action has also withdrawn the previous allegation that the PowerBuilder reference discloses a parser, and instead now relies upon MS Word to allegedly inherently show this feature.

Applicants respond to the updated rejections

Applicants remarks in Amendment B are believed to remain pertinent, and are incorporated herein by reference. The following additional remarks address the MS Word dialog windows newly cited in the present Office Action, and the next section herein addresses the Response to Arguments section of the present Office Action.

The new MS Word dialog windows applied in the present Office Action are cumulative to references previously of record. The present Office Action states:

> Figure 5 is the Find and Replace box available from the Edit menu, where the user has not yet entered any search items. Figure 5 discloses a text entry space in a <u>dialog box</u>

> displayed on a screen of the display device <u>for free form</u>
> <u>entry of text</u> by the user.
>
> ...
>
> <u>MS Word fails to disclose the selective display of a</u>
> <u>selection button</u> (i.e., the show-list-button) associated with
> the dialog box, where the selection button is visible when at
> least one text entry is stored in memory. In the examples
> described above <u>the show-list-button is always displayed</u>.

Office Action at page 4 (underscores added).

Thus, the newly cited dialog window of FIGURES 5-7 merely shows what the

Background of the present application previously described as prior art – a free-form

text entry dialog box with drop-down list of prior text entries, in which the drop-down list

button is always displayed. Such a dialog box can be confusing because when a novice

user first encounters it, he or she may believe it is a pure drop-down selection box and

be confused when operation of the drop-down list button fails to provide a list of

selectable entries. Said confused user may also fail to recognize the free-form text entry

option (which is the only viable option upon initially opening the dialog window) and may

therefore fail to successfully interact with the dialog box, or may be substantially

delayed in successful interaction due to the aforementioned confusion.

PowerBuilder provides for certain selectively displayable selection buttons. The

present Office Action notes:

> PowerBuilder 6 discloses dialog box controls that have
> intelligence built into them wherein the controls are
> conditionally displayed based upon the volume of items in
> memory. PowerBuilder 6 discloses controls built into the
> drop down box selection button (the arrow) on page 3.
> PowerBuilder recites: "*Always Show Arrow: The Always*
> *Show Arrow checkbox always shows the arrow that opens*
> *the list box. If Always Show Arrow is unchecked, <u>the arrow</u>*
> <u>*is shown only when the column has focus*</u>." PowerBuilder 6

> discloses conditional program execution related to visibility
> of the arrow.
>
> PowerBuilder 6 further discloses the conditional
> program execution of the visibility of controls in relation to
> the volume of data in the memory of the <u>list box</u> on page 2.
> PowerBuilder 6 recites: "*Disable Scroll: If Disabled Scroll is
> checked, the scroll bar will always be visible but will be
> disabled when you can access all the items without
> scrolling. If this property is not checked, the scroll bar will
> be displayed only if necessary, based on the number of
> items and the height of the <u>listbox</u>.*" So, if the listbox is set
> to a height equivalent to less than one line of text, and the
> memory is empty, then the scroll bar would not be
> displayed. Furthermore, in this example, if the memory
> holds one or more text items, the scroll bar would be visible.
> <u>PowerBuilder 6 discloses selectively displaying a text entry
> box control</u>, wherein the selective displaying is based upon
> the items stored in memory.

Office Action at pages 4-5 (underscores added).

Conspicuously missing from these PowerBuilder examples is any disclosure or fair

suggestion of provision for a drop-down arrow for a combination box that is shown only

when there are previous text entries to list. The first example relates to showing a

selection arrow upon focus. Such a selective displaying, even if incorporated into the

newly cited MS Word dialog box, would not solve the problem of user confusion. It

would merely delay the user's confusion until he or she focuses the mouse pointer onto

the dialog box. The second example relates to a listbox which does not provide

free-form text entry – hence, the Office Action's characterization of this example as

disclosing "selectively displaying a <u>text entry</u> box control" is inaccurate.

None of the previously or newly cited portions of MS Word, PowerBuilder, or their

combination, disclose or fairly suggest the features of claim 2 (at least the feature

"means for selectively displaying a selection button on the screen of the display device in association with the dialog box for selection by the pointing means, the selection button being displayed solely when the memory contains at least one previously entered text item" is not disclosed), claim 8 (at least the feature "displaying a drop-down list selection button on the screen of the display device only if the counting produces a value greater than zero" is not disclosed), and claim 21 (at least the feature "a drop-down list selection button displayed in conjunction with the free-form text entry portion only when the memory contains at least one previously entered free-form text entry" is not disclosed). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

Regarding dependent claim 6, Applicants find the present unpatentability rejection unclear. The Office Action now acknowledges that PowerBuilder does not disclose a parser (Office Action at page 9), but alleges that it is inherent to use a parser in any operating system within the assembly language, and particularly used by MS Word within the Windows operating system. *Id.* Applicants are unclear as to what is meant by the term "assembly language" and ask for clarification in the forthcoming Office Action. The referred to Windows operating system is a point-and-click graphical operating system which would not appear to require the use of a parser for parsing text entries. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is <u>necessarily</u> present in the thing described by the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. MPEP § 2112. If this rejection is to be maintained, Applicants respectfully ask for clarification of the grounds for rejection.

Applicants respond to the Response to Arguments section

Applicants' Amendment B noted that the Office Action mailed April 18, 2005 failed to provide motivation for the proposed combination of MS Word and PowerBuilder. In response, the present Office Action states:

> The applicant is directed to the rejection of claim 2 as revised above. MS Word clearly shows the text entry dialog box as claimed by applicant, where MS [W]ord is deficient with respect to the limitation directed toward selectively displaying the selection button based upon the number of items in the associated memory. Power[B]uilder 6 teaches the technique a programmer would use to build a text entry dialog box as claimed by applicant.

Office Action at page 8.

This Office Action response is a description of the <u>elements</u> of the proposed combination, but it does <u>not</u> propose a <u>motivation</u> for making the combination. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, <u>either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references</u>." MPEP §2142.

The present Office Action identifies no express or implied teaching <u>in the references</u> to make the proposed combination. Moreover, the Office Action does not provide a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious. It merely allegedly identifies pieces of the present

claims in two different references (as noted previously, Applicants do <u>not</u> agree that the references show all said pieces), and states that it would have been obvious to make the combination "in order to provide a visible indication that the control is usable." (Office Action at page 5).

<u>This proposed motivation is taken from the present application</u>. Nothing in the references alone or in combination suggests such a motivation. The references do not recognize that there is a problem with the combination box that is explicitly taught in newly cited MS Word FIGURES 5-7. MS Word certainly does not recognize the problem of confusion – it employs precisely the type of combination box that can confuse novice users. PowerBuilder does not recognize the problem – although it provides selectively displayed selectors, neither of the two selectively displayed selectors cited in the Office Action are directed toward alleviating the source of confusion addressed by the present application. The references cannot motivate making a combination to solve a problem that is not recognized in any of the references.

Because the Office Action does not provide a motivation for making the combination, a prima facie case of obviousness has not been made. Accordingly, Applicants have no duty to present rebuttal evidence supporting patentability.

Nonetheless, Applicants note that such rebuttal evidence exists. The references themselves teach away from the proposed combination. It is improper to combine references where the references teach away from their combination. MPEP § 2145, citing In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prima facie case of obvious may be rebutted by showing that the art, in any material respect,

teaches away from the claimed invention. MPEP § 2144.05, citing In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Here, the MS Word reference clearly teaches away from the claims of the present application. MS Word discloses <u>precisely</u> the type of combination box which the <u>present application</u> recognizes as confusing. But, MS Word does not recognize it as confusing – rather, MS Word employs that very combination box in a widely sold commercial word processing package. The skilled artisan considering MS Word would likely conclude that this combination box is entirely adequate, and would not be motivated to consider attempting to improve the dialog box.

Moreover, the level of skill in the art should be considered. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP § 2141.03. In considering the present application, the skilled artisan is likely to be someone with at least some familiarity with computers and GUI interfaces. The present Office Action states that "Power[B]uilder 6 teaches the technique a programmer would use to build a text entry dialog box as claimed by applicant" (Office Action at page 8) suggesting that the Examiner considers that the ordinary skilled artisan could, for example, be a computer programmer.

The relatively high level of computer skills of the ordinary artisan further rebuts a finding of obviousness of the present application. An insight of the present application is that a <u>novice</u> user, who is far removed from the level of the ordinary skilled artisan, might find the dialog box of MS Word FIGURES 5-7 confusing. The skilled artisan's familiarity with computers and GUI interfaces makes it difficult for the skilled artisan to recognize the potential for confusion on the part of the novice user.

Applicants respectfully request reconsideration and allowance of the

application

The newly cited MS Word dialog box adds nothing to the references of record. The Examiner has still failed to show that the references alone or in combination disclose or fairly suggest all the elements of the claims of the present application. For example, the references alone or in combination do not disclose or fairly suggest the element of claim 21 that a drop-down list selection button be displayed in conjunction with a free-form text entry portion only when a memory contains at least one previously entered free-form text entry.

Moreover, the proposed combination of MS Word and PowerBuilder appears to improperly employ the rejected claims as a blueprint for abstracting alleged individual teachings from the references. *See* Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 U.S.P.Q. 657 (Fed. Cir. 1985). Having abstracted the individual teachings, the Office Action then cites a motivation set forth only in the present application, and not in the references. Such hindsight based on the present application is impermissible. *See* MPEP § 2142. The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. MPEP § 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In view of the foregoing remarks, Applicants respectfully request that the application be reconsidered and pending claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22 be allowed.

CONCLUSION

In view of the above remarks, it is respectfully submitted that all pending claims are patentably distinct and unobvious over the references of record.

Allowance of all pending claims and early notice to that effect is respectfully requested.

Respectfully submitted,

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Dec. 30, 2005

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